



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,405	02/09/2004	Hiroshi Yoshigi	ASAM.0110	6609

7590 10/02/2006

Stanley P. Fisher
Reed Smith LLP
Suite 1400
3110 Fairview Park Drive
Falls Church, VA 22042-4503

EXAMINER

BANGACHON, WILLIAM L

ART UNIT	PAPER NUMBER
----------	--------------

2612

DATE MAILED: 10/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

SK

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/773,405

Applicant(s)

YOSHIGI ET AL.

Examiner

William L. Bangachon

Art Unit

2612

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 September 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 5,6 and 10-13.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☒ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

WENDY A. GARBER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's arguments with respect to claim 5 have been fully considered but they are not persuasive. DeVall shows in Figs. 3a and 3b that resonating circuits can be either series or parallel. Mathieu describes that as the capacitance of the chip (CS in Fig. 5) gets smaller and smaller, an input capacitance is added to compensate (so the overall capacitance stays the same) (Mathieu, col. 4, lines 22-33+). The particular design used by Mathieu is a parallel resonating circuit. With parallel circuits, the total capacitance is $CS1 + CS2$. As $CS1$ gets smaller, $CS2$ has to get larger to compensate. In a series circuit, the relationship between the two capacitors is $1/CS2 + 1/CS1$. As $CS1$ gets smaller, $CS2$ must also get smaller to compensate. Therefore, the series relationship is inverse to the parallel relationship. As Mathieu discloses a large capacitor is needed to compensate for the chip capacitor getting smaller and deVall discloses that either a parallel or series resonator can be used, it would have been obvious to use a series resonator in place of the parallel resonator disclosed by Mathieu. Once this replacement is done, it is inherent that first capacitor be smaller than the input capacitance to achieve the same effect. See also Teach Yourself Electricity and Electronics, 2nd Edition, by Stan Gibilisco, pages 202-203 and 318-319. In response to applicant's argument of unexpected results [Remarks, page 3, last paragraph], the proper course of action is for the applicant to provide an affidavit supplying the evidence of unexpected results. See MPEP 716.02, particularly 716.02(b). In response to applicant's arguments against the references individually [Remarks, page 4, 2nd paragraph], one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In view of the above observation, claims 5-6 and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over USP 5,608,417 (de Vall) in view of USP 6,522,308 (Mathieu).